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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,795	07/11/2001	Stanley C. Johnson	7060-3	1478
20575	7590	01/04/2008	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			RHEE, JANE J	
ART UNIT	PAPER NUMBER			
		1795		
MAIL DATE	DELIVERY MODE			
01/04/2008		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY C. JOHNSON

Appeal 2007-3995
Application 09/903,795¹
Technology Center 1700

Decided: January 4, 2008

Before ADRIENE LEPIANE HANLON, LINDA M. GAUDETTE, and
MARK NAGUMO, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 24-43. We have jurisdiction under 35 U.S.C. § 6(b).

The Examiner finally rejected claims 24-35 and 37-42 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Talbot, Robbins, and Hoffman. Final Office action mailed May 2, 2005 at 2.

¹ Application 09/903,795 was filed on July 11, 2001. The real party in interest is Pacific Wood Laminates, Inc. App. Br. 2.

The Examiner finally rejected claims 36 and 43 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Talbot, Robbins, Hoffman, and Nichols. Final Office action mailed May 2, 2005 at 2.

The Examiner relied on the following prior art:

Robbins	US 4,844,763	Jul. 4, 1989
Hoffman	US 5,071,688	Dec. 10, 1991
Talbot	US 5,234,519	Aug. 10, 1993
Nichols	US 5,569,505	Oct. 29, 1996

B. ISSUES

Whether the Appellant has shown that the Examiner erred in rejecting claims 24-35 and 37-42 under 35 U.S.C. § 103(a) as unpatentable over the combination of Talbot, Robbins, and Hoffman.

Whether the Appellant has shown that the Examiner erred in rejecting claims 36 and 43 under 35 U.S.C. § 103(a) as unpatentable over the combination of Talbot, Robbins, Hoffman, and Nichols.

C. FINDINGS OF FACT

The following findings of fact are believed to be supported by a preponderance of the evidence. Additional findings of fact as necessary appear in the Analysis portion of the opinion.

1. Appellant's invention

The Appellant's invention relates to a composite wood product for use in applications in the building industry, particularly as a fascia, trim, siding, or wall covering for exterior or interior use. Spec. 1:8-10.

The Appellant's invention includes three primary components: a laminated veneer lumber, treated paper, and adhesive. Spec. 2:25-26.

The laminated veneer lumber comprises a substrate. Spec. 3:10-11.

Treated paper is applied to the substrate using adhesive. Spec. 4:18-23.

The paper is wrapped around the substrate. Spec. 4:11-13.
Accordingly, when the substrate is installed on a building, all exposed surfaces of the substrate are sealed with treated paper. Spec. 5:14.

Treated paper is defined as a paper that is impregnated or surface treated with resin. Typical resins include phenolic, isocyanate, melamine, or acrylic. Spec. 3:23-24.

Other examples of treated paper include medium density overlay (MDO). Spec. 3:24-26; see also Spec. 1:25-26.

2. Appellant's claimed invention

Claim 24 reads as follows:

24. A wood product for use as exterior trim on the exterior of a building comprising:
an elongate composite substrate;
a core defining the interior of said substrate;
an elongate front surface formed on one side of said substrate;
an elongate rear surface formed on the other side of said substrate;
a pair of opposing edge surfaces extending between said front and rear surfaces, said core being exposed on said edge surfaces;
treated paper substantially covering and adhered to all of said front surface, said side surfaces,^[?] and at least a portion of said rear surface adjacent at least one of said edge surfaces, said covered portion being substantially all of said trim that is visible when said trim is installed on the building;
a resin treatment formed on at least the exposed surface of said paper; and

¹ Based on the record before us, we interpret "said side surfaces" to be the previously recited "pair of opposing edge surfaces." In the event of further prosecution, this issue can be developed if necessary.

adhesive spread between substantially all of said paper and said substrate.

3. Talbot

The invention disclosed in Talbot relates to veneer-wrapped products. Talbot 1:6-10.

According to Talbot, wood moldings manufactured from solid lumber are subject to warping and unpredictable changes in dimension as the moisture content of the molding changes. Talbot 1:21-24.

To overcome these problems, methods have been developed to apply thin wood veneers to substrates composed of low-cost wood particle board, lumber core, and the like. Talbot 1:25-28.

According to the invention disclosed in Talbot, thin veneers are wrapped around three sides of a rectangular substrate so as to cover all four corners of the substrate. When the veneer-wrapped molding is applied around doorways and windows, the veneer appears from all visible faces to be constructed of solid wood. Talbot 1:29-39.

The veneer is bonded to the substrate by an adhesive. Talbot 3:60-61.

Any suitable wood veneer, such as oak, birch, and pine, may be used in the invention of Talbot. 7:62-66.

4. Robbins

Robbins discloses composite laminated panels having wood veneer surfaces. The panels are said to have a reduced cost and improved dimensional stability. Robbins 1:18-23.

These laminated panels are said to be useful for replacing lumber in building construction and are suitable substitutes for conventional lumber or plywood. Robbins 1:23-27.

Veneers can include pine, oak, or any suitable wood. Robbins 7:10-14.

Paper may be substituted for the surface veneer sheet or may be adhesively bonded to the exposed surfaces of the wood veneer sheets. Robbins 7:14-18.

5. Hoffman

Hoffman discloses a plywood product for use in the building industry as a trim and/or wall covering product for either exterior or interior use.

Hoffman 1:5-10.

More particularly, the invention includes an article of manufacture comprising a plywood building trim product composed of several plies of wood. Hoffman 2:38-44.

The appearance side of the article is entirely covered by a medium density fiber overlay (MDO). Hoffman 2:54-55.

Medium density fiber overlay is said to have a superior smooth paintable long lasting surface. Hoffman 3:38-42.

The appearance side and the ply edges of the article are covered by an acrylic paint which is said to provide high resistance against conditions affecting appearance and longevity. Hoffman 2:63-67.

D. PRINCIPLES OF LAW

A claimed invention is not patentable if the subject matter of the invention would have been obvious to a person having ordinary skill in the art at the time the invention was made. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Facts relevant to a determination of obviousness include (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art, and (4) any relevant objective evidence of obviousness or non-obviousness. *KSR*, 127 S. Ct. at 1734; *Graham*, 383 U.S. at 17-18.

One of ordinary skill in the art is presumed to have skills apart from what the prior art references expressly disclose. See *In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985). A person of ordinary skill is also a person of ordinary creativity, not an automaton. *KSR*, 127 S. Ct. at 1742.

The question under 35 U.S.C. § 103 is not merely what the references teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. All disclosures of the prior art must be considered. *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976).

Any judgment on obviousness is in a sense a reconstruction based on hindsight reasoning. However, as long as the judgment takes into account only knowledge that was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from an applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

In determining whether the subject matter of a claim is obvious, neither the particular motivation nor the avowed purpose of the inventor controls. *KSR*, 127 S. Ct. at 1741-42.

The motivation in the prior art to combine the teachings of the references need not be the same as that of the applicant to establish obviousness. *In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996).

An express suggestion to substitute one equivalent for another need not be present to render such a substitution obvious. *In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

For obviousness under 35 U.S.C § 103(a), all that is required is a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988).

A rejection premised upon a proper combination of references cannot be overcome by attacking the references individually. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

Objective evidence of obviousness or non-obviousness includes commercial success, long felt but unsolved needs, failure of others, and copying. *Graham*, 383 U.S. at 17-18; *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996).

For objective evidence to be accorded substantial weight, an applicant must establish a nexus between the evidence and the merits of the claimed invention. *In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995).

Proof of commercial success is not simply a matter of producing sales figures. An applicant must produce hard evidence of commercial success, such as market share data. *Huang*, 100 F.3d at 139-40.

Evidence of a long felt need must show that the problem solved by an applicant's invention was known but not solved prior to the invention. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1325 (Fed. Cir. 1999); *see also Newell Co., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988).

To show a failure of others, the evidence must establish that others skilled in the art tried and failed to find a solution for the problem solved by the applicant. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540 (Fed.

Cir. 1983). One must also show that the others who failed had knowledge of the critical prior art. *In re Caveney*, 386 F.2d 917, 923 (CCPA 1967).

Absent a showing of long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness. *Iron Grip Barbell Company, Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1324-25 (Fed. Cir. 2004).

The ages of references are not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem. *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977).

As for copying, “more than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue.” *GPAC*, 57 F.3d at 1580 (citing *Cable Elec. Prods. v. Genmark, Inc.*, 770 F.2d 1015, 1028 (Fed. Cir. 1985)).

An affidavit fails in its purpose if it recites conclusions and few facts to buttress those conclusions. *In re Brandstadter*, 484 F.2d 1395, 1406 (CCPA 1973).

Nothing in the rules or in jurisprudence requires the fact finder to credit unsupported or conclusory assertions. *Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997).

E. ANALYSIS

1. Claim 24

The Examiner found that Talbot discloses a wood product comprising a substrate and a veneer substantially covering and adhered to the front surface, side surfaces, and at least a portion of the rear surface of the

substrate. See Talbot, Fig. 1. The only difference between the wood product disclosed in Talbot and the subject matter of claim 24 is that the wood product in Talbot is covered with a veneer rather than a treated paper. Ans. 3-4.³

Robbins discloses a wood product comprising composite laminated panels having wood veneer surfaces. The Examiner found that Robbins discloses that paper may be substituted for the surface veneer sheet. Ans. 4.

The Examiner found that Hoffman discloses an engineered wood product having a resin treatment on its exposed surface, i.e., a medium density fiber overlay covered with an acrylic paint. The Examiner found that the resin treatment produces a planar smooth surface. Ans. 5; Hoffman 2:51-67.

The Examiner concluded that the subject matter of claim 24 would have been obvious to one of ordinary skill in the art in view of the combined teachings of Talbot, Robbins, and Hoffman. Ans. 5.

The Appellant argues that the paper in Robbins solves a different problem than the claimed invention, i.e., the paper in Robbins improves dimensional stability of laminated veneer lumber. Therefore, the Appellant argues that there would have been no motivation to combine the teachings of Robbins and Talbot and arrive at the claimed invention. App. Br. 6-7.⁴

As explained in *KSR*, neither the particular motivation nor the avowed purpose of the Appellant controls when determining whether the claimed subject matter is obvious. *KSR*, 127 S. Ct. at 1741-42. Robbins teaches one of ordinary skill in the art that paper is a suitable substitute for a veneer sheet in an engineered wood product. Robbins 7:14-18. This teaching of

³ Examiner's Answer mailed March 20, 2007.

⁴ Amended Appellant's Brief received September 6, 2006.

equivalence is sufficient to establish the obviousness of substituting the wood veneer in Talbot for paper as in Robbins. *Fout*, 675 F.2d at 301.

The Appellant also argues that Robbins does not disclose that the side surfaces of the panel are covered with paper, and Hoffman does not disclose that the side surfaces of the substrate are covered with a medium density fiber overlay (a treated paper). Therefore, the Appellant argues that the combined teachings of Talbot, Robbins, and Hoffman do not suggest a substrate wherein the side surfaces are covered with a treated paper as in the claimed invention. App. Br. 7-8.

It is well settled that a rejection premised upon a proper combination of references cannot be overcome by attacking the references individually. *Keller*, 642 F.2d at 426. As discussed above, Talbot discloses an engineered wood product covered on the front and side surfaces with a thin veneer. The Examiner merely relied on Robbins and Hoffman to establish that it would have been obvious to one of ordinary skill in the art to substitute the veneer in Talbot with a treated paper.

Based on the foregoing, it is reasonable to conclude that the subject matter of claim 24 would have been *prima facie* obvious to one of ordinary skill in the art in view of the combined teachings of Talbot, Robbins, and Hoffman. In rebuttal, the Appellant relies on evidence of secondary considerations, namely commercial success, long-felt need, failure of others, and copying, to rebut the *prima facie* case of obviousness. App. Br. 9-12.

As for commercial success, the Appellant argues that “the product disclosed in the present application” has enjoyed recent commercial success. For support, the Appellant relies on paragraphs 2-4 of a Declaration of Ken

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Caylor dated October 20, 2003, and paragraphs 2-5 of a Declaration of Bill Sanregret dated October 21, 2003. App. Br. 9-10.

According to the Sanregret Declaration:

Mr. Sanregret is a salesman for Capital Lumber Company (CLC).

Sanregret Declaration, para. 1.

CLC purchases engineered lumber products from Pacific Wood Laminates, Inc. (PWL). Sanregret Declaration, para. 2.

About eighteen (18) customers are currently purchasing the new product, in which paper extends from the face of the product around the edge to the back, thereby wrapping and sealing the edge. Sanregret Declaration, para. 5.

According to the Caylor Declaration:

Mr. Caylor is employed by PWL. Caylor Declaration, para. 1.

A new product (“the wrapped edge product”), said to be the subject of the application on appeal, is “uniformly straight, smooth, and true.” Caylor Declaration, para. 2.

A major homebuilder has used the new wrapped product “made in accordance with the invention claimed in this patent application.” Caylor Declaration, para. 3. The new product has also been successfully sold to two (2) New York distributors. Caylor Declaration, para. 4.

Exhibit A attached to the Caylor Declaration is an e-mail from a PWL customer. The e-mail was sent to Mr. Caylor after he told the customer about the wrapped edge product but *before* PWL was selling the new product. The e-mail is said to illustrate the desire for the new product. Caylor Declaration, para. 5.

These declarations do not establish commercial success for at least two reasons. First, the declarations do not establish a nexus between the Appellant's *claimed* invention and any sales success. In other words, the declarations do not establish that the customers who purchased the "new" product or the product "made in accordance with the invention claimed in this patent application" did so based on the features of the claimed invention. To the extent that the evidence shows that customers were interested in the wrapped edge of the "new" product, we note that a wrapped edge in an engineered wood product is disclosed in Talbot.

Second, the declarations do not present any actual sales data or market share data. A description of several instances of customers purchasing the "new" product and the promise of future sales are not sufficient to show commercial success. *Huang*, 100 F.3d at 139-40.

As for long-felt need, the Appellant argues that Robbins at column 2, line 65 to column 3, line 2, Hoffman at column 2, lines 25-35, and the Appellant's Specification at pages 1 and 2 make clear that there is a need in the construction industry for "inexpensive, durable, paintable, weatherable, laminated veneer lumber." The Appellant argues that customer complaints establish that the need for such a product was unsolved at the time of the Appellant's invention. For support the Appellant relies on paragraphs 3 and 6-8 of a Declaration of Stanley C. Johnson dated October 22, 2003^{5,6} and Exhibits B through E attached thereto. App. Br. 10-11.

⁵ Stanley C. Johnson is the named inventor of the application involved in this appeal. Johnson Declaration, para. 1.

⁶ The Appellant also filed a Supplemental Johnson Declaration dated November 17, 2003. Throughout this opinion we refer to the Johnson Declaration dated October 22, 2003.

According to the Johnson Declaration, the customer complaints were directed to an “old PWL product” which is said to have paper applied to a face surface as well as sanded and filled edges as in Hoffman. Johnson Declaration, para. 3. However, prior to the Appellant’s invention, Talbot described a veneer-wrapped engineered wood product. The Appellant has not explained why the long-felt need defined by the Appellant was not solved by Talbot. *Al-Site*, 174 F.3d at 1325; *see also Newell*, 864 F.2d at 768.

The Appellant also argues that paragraphs 12-17 of the Johnson Declaration establish a failure of others. App. Br. 11.

The Appellant does not specifically define the problem that the inventor, either working alone or with others, failed to solve. To the extent that the problem is the need for “inexpensive, durable, paintable, weatherable, laminated veneer lumber,” the Appellant has not explained why Talbot did not solve this problem. Furthermore, there is no indication that the inventor and others working with him were aware of the critical prior art, such as Talbot, during the time they failed. *Caveney*, 386 F.2d at 923. Finally, in his Declaration, Mr. Johnson states that he attempted to improve the old PWL product in 1998. Mr. Johnson does not indicate that this attempt was unsuccessful. See Johnson Declaration, para. 15.

The Appellant also argues that Robbins, Hoffman, and Talbot have been known collectively since 1993, but in the eight years leading up to the Appellant’s invention no one has produced the claimed invention. App. Br. 9.

The Appellant does not direct us to any credible evidence supporting this argument. In addition, the Appellant has not established a long-felt need

or a failure of others. Absent such a showing, the mere passage of time without the claimed invention is not evidence of nonobviousness. *Iron Grip*, 392 F.3d at 1324-25; see also *Wright*, 569 F.2d at 1127.

Finally, relying on paragraph 18 of the Johnson Declaration, the Appellant argues that a product manufactured by Veneer Profiles copied the Appellant's product. App. Br. 12. According to the Johnson Declaration, "As far as I know, this sample was introduced to the market after PWL's new trim product, and it copies our new trim product, but it is of inferior quality." Johnson Declaration, para. 18.

This evidence is not persuasive of copying for several reasons. First, the Appellant has not shown that Veneer Profiles was aware of or had access to the Appellant's claimed invention at the time Veneer Profiles introduced its product to the market. See *Cable Elec.*, 770 F.2d at 1027. Second, Mr. Johnson merely alleges that Veneer Profiles copied "PWL's new trim product," not the Appellant's *claimed* invention. Finally, the Appellant has failed to establish a nexus between the alleged copying and the merits of the claimed invention. Indeed, Mr. Johnson indicates that the Veneer Profiles product is of "inferior quality."

In sum, considering the record as a whole, we conclude that the invention of claim 24 would have been obvious to one of ordinary skill in the art in view of the combined teachings of Talbot, Robbins, and Hoffman.

The Appellant does not argue the patentability of claims 25-35 and 37-42 separately. App. Br. 6. Accordingly, these claims fall with claim 24.

2. Claims 36 and 43

The Appellant argues that claims 36 and 43 are allowable because the claims from which they depend, claims 24 and 37, respectively, are

allowable. App. Br. 13. The Appellant does not otherwise dispute the Examiner's findings or conclusion of obviousness as to claims 36 and 43.

Claims 24 and 37 are not patentable for the reasons set forth above. Therefore, claims 36 and 43 are likewise unpatentable.

F. CONCLUSIONS OF LAW

The Appellant has not shown that the Examiner erred in rejecting claims 24-35 and 37-42 under 35 U.S.C. § 103(a) as unpatentable over the combination of Talbot, Robbins, and Hoffman.

The Appellant has not shown that the Examiner erred in rejecting claims 36 and 43 under 35 U.S.C. § 103(a) as unpatentable over the combination of Talbot, Robbins, Hoffman, and Nichols.

G. DECISION

The rejection of claims 24-35 and 37-42 under 35 U.S.C. § 103(a) as unpatentable over the combination of Talbot, Robbins, and Hoffman is affirmed.

The rejection of claims 36 and 43 under 35 U.S.C. § 103(a) as unpatentable over the combination of Talbot, Robbins, Hoffman, and Nichols is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 35 U.S.C. § 1.136(a) (2006).

AFFIRMED

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